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T-B

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/307,195 05/07/99 COHN

W BIH97-04A2

EXAMINER

QM12/0618

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ART UNIT

PAPER NUMBER

8

3732
DATE MAILED:

06/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

	Application No.	Applicant(s)
	09/307,195	COHN, WILLIAM
Examiner	Art Unit	
Jeffrey A. Smith	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 April 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 37-40 is/are allowed.
- 6) Claim(s) 1-14, 16-19, 21, 22, 24-36, and 41-50 is/are rejected.
- 7) Claim(s) 15, 20 and 23 is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 18) Interview Summary (PTO-413) Paper No(s) _____.
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5-10, 12-14, 16, 18, 19, 22, 24-27, 29-34, 36, 41, 42, and 44-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Benetti et al. (U.S. Patent No. 5,894,843).

Benetti et al. discloses (Fig. 7) a surgical device (60) comprising a retaining element (62) having an aperture (61); a plurality of suture holders (70); a handle (69); and a tab (63). A method including the steps of positioning, occluding, and connecting are disclosed (col. 12, lines 5-27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 11, 17, 21, 28, 35, 43, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al. (U.S. Patent No. 5,894,843).

Although Benetti et al. does not disclose irrigation or suction, it would have been obvious to one of ordinary skill in the art to have provided the device reported above to have included such structure because the use of irrigation and suction are well-known for use during surgeries of the type disclosed by Benetti et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-50 are rejected under the judicially created doctrine of double patenting over claims 1-65 of U. S. Patent No. 6,033,362 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

Notwithstanding the Double Patenting rejection:

Claims 15, 20, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 37-40 are allowed.

Response to Arguments

Applicant's arguments deposited 04 April 2001 have been fully considered but they are not persuasive.

Applicant's remarks that "Benetti thus fails to disclose or suggest a holder that can attach to a connector, such as a suture line, and that can position the connector to compress an artery against a retaining element surface" is not persuasive.

Benetti et al. '843 is replete with reference to devices (or retractors) comprising a holder on a retaining element (or base) that hold a connector (i.e. a suture line) that positions the connector to compress the cardiac tissue of the operative site against a retaining element surface. Although Benetti et al. does not expound upon port 70 in their description of the embodiment of Fig. 7, they do refer to such port's utility (i.e. "for receiving a suture line" (col. 12, lines 26-27). Benetti et al. details the full utility of such suture line receiving port in reference to previous embodiments (see col. 10, lines 57-62; col. 11, lines 19-30; col. 11, line 60-col. 12, line 4). Benetti et al. further teaches that "[i]n some embodiments, as described herein, the contact members 1 may have apertures, openings or attachments to facilitate connection with sutures or

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other devices to achieve the requisite stabilization" (col. 7, lines 20-24).

The Examiner believes that the entirety of the single Benetti et al. disclosure anticipates Applicant's claims because the disclosure reasonably teaches the full utility of the ports 70 as for receiving a suture line for administering the requisite stabilization of the operative site (e.g. cardiac tissue (col. 11, line 67-col. 12, line 4)) and for depressing the tissue adjacent the target artery (col. 11, lines 27-30).

In specific address of Applicant's remarks that "[t]here is no disclosure or suggestion in Benetti that ports 70 can be used to attach a suture line to the 'stabilizing means 60' to compress and occlude an artery" (Emphasis Added), the Examiner notes that Benetti et al. provides an "occluder" 63 at either or both ends of the aperture 61. Benetti et al. discloses that the occluders "[extend] below the surface 62 and [engage] the target artery to substantially reduce or eliminate the flow of blood through the artery" (col. 12, lines 9-12). The Examiner believes that Applicant's recitations with respect to the holder and connector "read on" the occluder and suture arrangement disclosed by Benetti et al.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on 703-308-2696. The fax phone numbers for the organization where this application or proceeding is assigned

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are 703-305-3590 for regular communications and 703-305-3590 for
After Final communications.

Any inquiry of a general nature or relating to the status
of this application or proceeding should be directed to the
receptionist whose telephone number is 703-308-0858.



Jeffrey A. Smith
Primary Examiner
Art Unit 3732

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June 17, 2001